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PATENTS

Attorney Docket Number 111025.124  
(formerly 10845/014002)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Nash

Serial No.: 09/373,018

Filing Date: August 11, 1999

Title: **Method for Producing and Screening  
Mass-Coded Combinatorial Libraries for  
Drug Discovery and Target Validation**

Art Unit: 1631

Examiner: M. Moran

HLS  
Plunkett  
4/12/01

Commissioner for Patents  
Washington, DC 20231

CERTIFICATION UNDER 37 CFR § 1.8(a)

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3/28/01

Date of Signature and  
of Mail Deposit

*Jo-Ann Bergantino*  
Jo-Ann Bergantino

RESPONSE TO RESTRICTION REQUIREMENT

Dear Commissioner for Patents:

In the Office communication mailed on February 12, 2001, restriction is required under 35 U.S.C. § 121. Applicant respectfully traverses the restriction as between Groups I and II.

The inventions of Group I (claims 16-22 and 51-53) and Group II (claims 54-63) are each drawn to a method of identifying a ligand for a biomolecule. As acknowledged by the Examiner, the method of Group II incorporates the steps of Group I. In fact, the method of Group II is, in essence, the method of Group I performed in an iterative fashion. Applicant believes, therefore, that simultaneous search and examination of Groups I and II can be made

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without serious burden. Accordingly, Applicant respectfully request that the restriction between Groups I and II be reconsidered and withdrawn.

Subject to the foregoing remarks, Applicant hereby elects for examination the invention of Group I, claims 16-22 and 51-53.

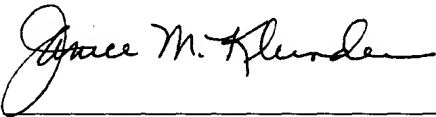
In addition, Applicant makes a provisional election of species as follows:

|                               |  |
|-------------------------------|--|
| First biomolecule:            | protein  |
| Second biomolecule:           | protein which is not a derivative of the first protein |
| Scaffold precursor:           | fused ring system                                      |
| Reactive group:               | acid chloride  |
| Peripheral moiety precursors: | amines   |

Applicant encloses a Petition for a One-Month Extension of Time pursuant to 37 C.F.R. § 1.136, up to and including April 12, 2001, for responding to the Office communication mailed on February 12, 2001.

No other fees are believed to be due in connection with this response. However, please charge any payments due or credit any overpayments to our Deposit Account No. 08-0219.

Respectfully submitted,



Janice M. Klunder, Ph.D.  
Reg. No. 41,121

March 28, 2001

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Approved for use through 09/30/2000. OMB 0651-0031

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|--|-----------------------------|--|
| <b>TRANSMITTAL FORM</b><br><i>(to be used for all correspondence after initial filing)</i> | <b>Application Number</b>   | 09/373,018                               |
|  | <b>Filing Date</b>          | August 11, 1999                          |
|  | <b>First Named Inventor</b> | Nash                                     |
|  | <b>Group Art Unit</b>       | 1631                                     |
|  | <b>Examiner Name</b>        | M. Moran                                 |
| <b>Total Number of Pages in This Submission</b>  |                             | <b>Attorney Docket Number</b> 111025.124 |

| ENCLOSURES (check all that apply)  |   |  |
|--|---|--|
| <input type="checkbox"/> Fee Transmittal Form                                | <input type="checkbox"/> Assignment Papers (for an Application)                         | <input type="checkbox"/> After Allowance Communication to Group                            |
| <input type="checkbox"/> Fee Attached  | <input type="checkbox"/> Drawing(s)   | <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences        |
| <input checked="" type="checkbox"/> Amendment / Response                     | <input type="checkbox"/> Licensing-related Papers                                       | <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) |
| <input type="checkbox"/> After Final   | <input type="checkbox"/> Petition Routing Slip (PTO/SB/69) and Accompanying Petition    | <input type="checkbox"/> Proprietary Information   |
| <input type="checkbox"/> Affidavits/declaration(s)                           | <input type="checkbox"/> Petition to Convert to a Provisional Application               | <input type="checkbox"/> Status Letter   |
| <input checked="" type="checkbox"/> Extension of Time Request                | <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address | <input checked="" type="checkbox"/> Additional Enclosure(s) (please identify below)        |
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| <input type="checkbox"/> Certified Copy of Priority Document(s)              | <input type="checkbox"/> Request for Refund   |  |
| <input type="checkbox"/> Response to Missing Parts/Incomplete Application    | Remarks   |  |
| <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 |   |  |

| SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT |                   |
|--|-------------------|
| Firm or Individual name                    | Hale and Dorr LLP |
| Signature                                  |                   |
| Date                                       |                   |

| CERTIFICATE OF MAILING  |                          |
|---|--------------------------|
| I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on this date <u>March 28, 2001</u> |                          |
| Typed or printed name   | Janice M. Klunder, Ph.D. |
| Signature   | <u>Janice M. Klunder</u> |
| Date  | 3/28/01                  |

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